

REMARKS

Originally-filed Claims 1-27 have been cancelled without prejudice.

New Claims 28-36 are presented for consideration.

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The specification now contains a recitation of the entire history of all prior patent applications for the subject application.

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Support for new Claims 28-36 can be found in the Description of the Invention of the Specification as follows:

Newly-presented Claims

28 - 33

34 - 36

Support

Page 6, lines 12-16

Page 6, lines 21-23

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Originally-filed Claims 2-15, 18, 19, 22 and 23 were rejected under 35 U.S.C. §112, second paragraph. Originally-filed Claims 1-6, 13 and 15-27 were rejected under judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5, 7, 8, 11-15, 17, 18, 21-25, 27, 28 and 31-33 of U.S. Patent No. 4,087,634 and over claims 1-10 of U.S. Patent No. 5,238,952. Originally-filed Claims 1-6, 13 and 15,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,087,634 to Reitz et al (hereinafter "Reitz U.S. '634").

Each of these rejections is rendered moot by cancellation of Claims 1-27.

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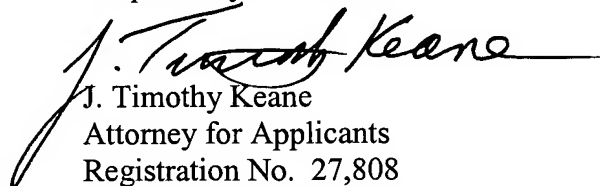
New Claims 28-36 are directed to a method-of-use invention requiring use of a compound selected from seven species compounds. Those seven compounds are also claimed in the issued parent patent of this application, i.e., U.S. Patent No. 6,630,497 (hereinafter '497 patent). These seven compounds correspond with compounds made and tested as described in Applicants' Table I at Page 82 of the Specification. These specific compounds, i.e., 2-/4-/6-substituted 1-phenyl imidazole-2-one, were neither taught nor suggested in Reitz U.S. '634 and thus were recognized as novel and non-obvious from Reitz U.S. '634. Therefore, the '497 patent issued with claims covering such compounds.

New Claims 28-36 are directed to a method of using the novel compounds as claimed in '497 patent. As a method of using new compounds is regarded as *per se* non-obvious, these new claims are non-obvious from prior art, including Reitz U.S. '634.

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New Claims 28-36 should now be in condition for allowance.

Respectfully submitted,


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